



Paper No. 16

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**OFFICE OF PETITIONS  
ON PETITION**

In re Application of  
Li, et al.  
Application No. 09/750,779  
Filed: January 2, 2001  
Attorney Docket No. 12013/55202  
For: CONTROLLED DELIVERY OF  
THERAPEUTIC AGENTS BY INSERTABLE  
MEDICAL DEVICES

This is a decision on the petition under 37 CFR 1.78(a)(6), filed August 20, 2003, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of prior-filed provisional Application No. 60/173,743, filed December 30, 1999.

Generally, a claim of benefit under 35 U.S.C. 119(e) is required to be filed during the pendency of the nonprovisional application that seeks to claim the invention disclosed in an earlier-filed provisional application.<sup>1</sup> However, when the nonprovisional application is filed on or after November 29, 2000, as is in the instant case, the claim of benefit must be filed **not merely** during the pendency of the nonprovisional application, **but** within either 4 months of its filing date, or 16 months of the filing date of the provisional application, whichever is later.<sup>2</sup>

The claim of benefit submitted with the instant petition is filed during the pendency of the nonprovisional application, but subsequent to May 2, 2001.<sup>3</sup> Such a delayed claim of benefit under 35 U.S.C. 119(e) may be accepted under a petition that includes:

- (1) The claim of benefit (in the form of a specific reference to the provisional application) in an application data sheet or in the first sentence of the specification following the invention title, unless previously submitted;

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<sup>1</sup> Assuming the following conditions are also met: (1) the nonprovisional application is filed within 12 months of the filing date of the provisional application; (2) the provisional application is entitled to a filing date, has at least 1 common inventor as that named in the nonprovisional application, and discloses that common inventor's invention which is claimed in at least 1 claim of the nonprovisional application; (3) the basic filing fee for the provisional application has been paid. 35 U.S.C. 119(e)(1); 37 CFR 1.78(a)(4).

<sup>2</sup> 37 CFR 1.78(a)(5)(ii). In the instant case, the claim for benefit must be filed no later than May 2, 2001 (4 months after the January 2, 2001 filing date of the instant nonprovisional application), which is later than April 30, 2001 (16 months after the December 30, 1999 filing date of the provisional application).

<sup>3</sup> See supra note 2.

- (2) The \$1,300 surcharge set forth in 37 CFR 1.17(t);<sup>4</sup>
- (3) A statement that the entire delay (between the time the claim of benefit was due and the filing of the claim) was unintentional.<sup>5</sup>

This petition lacks (1) above.

A reference to add the above-noted, prior-filed application on page one following the first sentence of the specification has been included in an amendment filed on August 20, 2003. However, the amendment is not acceptable as drafted since it improperly incorporates by reference the prior application. Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew a distinction between a permissible 35 U.S.C. § 120 statement and the impermissible introduction of new matter by way of incorporation by reference in a 35 U.S.C. § 120 statement. The court specifically stated:

Section 120 merely provides a mechanism whereby an application becomes entitled to benefit of the filing date of an earlier application disclosing the same subject matter. Common subject matter must be disclosed, in both applications, either specifically or by an express incorporation-by-reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. In re deSeversky, *supra* at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore, "limit" the absolute and express prohibition against new matter contained in section 251.

While petitioner has supplied a section 119 statement rather than a 120 statement for benefit, the above analysis applies. MPEP 201.11. Accordingly, before the petition under 37 CFR 1.78(a)(6) can be granted, a substitute amendment deleting the incorporation by reference statement is required.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                      Mail Stop Petition  
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<sup>4</sup> 37 CFR 1.78(a)(6)(ii). The fee has been charged to Deposit Account No. 11-0600 as authorized in the petition.

<sup>5</sup> 37 CFR 1.78(a)(6)(iii); contained in petition.

Any questions concerning this matter may be directed to Senior Petitions Attorney E. Shirene Willis at (703) 308-6712 .

A handwritten signature in black ink, appearing to read "B. M. Flanagan", with a stylized flourish at the end.

Beverly M. Flanagan  
Supervisory Petitions Examiner  
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